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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,956	02/19/2002	Shuichi Hirayama	SN-US025009	3435

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EXAMINER

ARNOLD III, TROY G

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/076,956

Applicant(s)

HIRAYAMA, SHUICHI

Examiner

Troy Arnold

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 11, there does not appear to be adequate support in the specification for a foam layer exterior to the thermoformable layer.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the term "non-thermoformable" is vague and indefinite; it is unclear exactly what this negative limitation means. Is newspaper non-thermoformable? Clay? In claim 3, a non-thermoformable member is claimed to be on the outer side of the ankle section, but claim 2 claims a member on the inner side, and claim 1 only claims one member, either on the inner or outer side. Claim 4 appears

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to be redundant to claim 2. Claim 10 is grammatically unclear. In claims 11-13, the term "overly" is not understood in the context of the claims. The definition of the word does not match the context. In claim 25, there is no antecedent basis for "said tightening device."

As a point of clarification, the terms "inner" and "outer" as in "an inner side and an outer side of said ankle section" are being taken in the context of the disclosure to mean inner and outer to the leg of the wearer, not inner and outer with reference to the shell of the boot liner itself.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9, 10, 12, 13 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Pozzobon, US Patent No. 6,012,236. Regarding claim 1, Pozzobon teaches a boot liner 1 comprising a sole portion and an upper portion having a foot section coupled to said sole portion, an ankle section extending upwardly from the foot section and a leg section extending upwardly from the ankle section, the upper portion including a thermoformable layer 3 or 103 located on an inner and outer side of the ankle section and a first non-thermoformable member (one of the raised surfaces 6 of either 5 or 105) located in one of the inner and outer sides of the ankle section.

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Although it is not explicitly stated that item 5 or 105 is "non-thermoformable," it is assumed to be based on the fact that item 3 or 103 IS thermoformable, and also in light of the 112-2 rejection made above Regarding claims 2 and 3, there are non-thermoformable members 6 on both the inner and outer sides of the ankle section. Regarding claim 4, there are multiple non-thermoformable members 6 in the ankle section. Regarding claims 9 and 10, the thermoformable layer 3 or 103 of Pozzobon extends along the entire body of his boot liner. Regarding claim 12, item 2 or 102 is an outer layer on an exterior facing surface of the thermoformable layer 3/103. Regarding claim 23, Pozzobon's sole portion includes a thermoformable layer 3/103.

Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pozzobon. If exterior layer 2/102 of Pozzobon is not a "foam" material per se, it would have been obvious to make it one for any of its well known useful properties such as heat retention or shock absorption.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon in view of Okajima, US Patent No. 6,035,558. Pozzobon teaches all the limitations of claim 5 except the non-thermoformable members being

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banana-shaped. Okajima teaches ankle pads 170 in exactly the same place as those claimed, and for the same purpose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate banana-shaped pads such as those taught by Okajima into the invention of Pozzobon for the purpose of making the boot more comfortable for the wearer by padding the hollow behind the ankles. Regarding claim 7, if Okajima's pads are not 70 by 70 mm, it would have been obvious to make them so in the course of routine design optimization. Claim 14 is rejected in the same manner as claim 5, and claim 16 as claim 7.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon as applied to claim 5 above, and further in view of Official Notice. Pozzobon as modified teaches all the limitations of claim 6 except the non-thermoformable members being formed of polyurethane. Official Notice is taken that polyurethane is old, obvious and well known in the sport footwear arts. It would have been obvious in view of Official Notice taken to one of ordinary skill in the art at the time the invention was made to make the non-thermoformable member of Pozzobon out of polyurethane for the any of its well known qualities such as cost, ease of manufacture, durability, etc.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon as applied to claim 7 above, and further in view of Okajima, US Patent No 5,946,827. Pozzobon as modified teaches all the limitations of claim 8 except a tightening device with the overlying straps as claimed. Okajima '827 teaches a support harness / tightening device for snowboard boots, with straps. As will be seen from Fig 1 of Okajima '827, the straps will overlies the banana shaped members of Pozzobon as

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modified. It would have been obvious in view of Okajima '827 to one of ordinary skill in the art at the time the invention was made to incorporate the tightening device of Okajima '827 into the invention of Pozzobon for the purpose of ensuring a snugger fit of his inner boot.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon in view of Official Notice. Pozzobon teaches all the limitations of claim 15 except the non-thermoformable members being polyurethane. Official Notice is taken that polyurethane is old, obvious and well known in the sport footwear arts. It would have been obvious in view of Official Notice taken to one of ordinary skill in the art at the time the invention was made to make the non-thermoformable members of Pozzobon out of polyurethane for the any of its well known qualities such as cost, ease of manufacture, durability, etc.

Claims 17-19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon in view of Dalvy et al and Donnelly. Pozzobon teaches all the limitations of claim 17 and 19 except the sole portion being a separate coupled member. Dalvy teaches an inner boot with a separate sole portion at the bottom as seen in Fig 2. Donnelly also teaches a separate sole section 54 as seen in Fig 9. It would have been obvious in view of either Dalvy or Donnelly to one of ordinary skill in the art at the time the invention was made to make the sole portion of the inner boot of Pozzobon separate for the purpose of allowing it to be made with a different traction surface or material surface. Regarding claim 18, Pozzobon's sole is flexible.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon as applied to claim 19 above, and further in view of Official Notice. Pozzobon as modified teaches all the limitations of claim 20 except the outer sole portion including an exterior layer of polyvinyl chloride. Official Notice is taken that polyvinyl chloride or PVC is old, obvious and well known in the footwear arts. It would have been obvious in view of Official Notice taken to one of ordinary skill in the art at the time the invention was made to incorporate an exterior portion of PVC into the sole portion of Pozzobon for any of the material's well known properties, such as wear resistance. Regarding claims 21 and 22, Pozzobon's boot liner includes a thermoformable layer 3/103 on the interior and an inner section 8/108 that overlies the outer sole section.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pozzobon in view of Donnelly and Okajima '827. Pozzobon teaches all the limitations of claim 24 except the tongue and slit, and the tightening device. Donnelly teaches an inner boot with a tongue and a slit. Pozzobon's structure appears to be the full functional equivalent of that claimed. Further, the tongue and slit arrangement is not claimed to be critical to the instant invention. It would have been obvious in view of Donnelly to one of ordinary skill in the art at the time the invention was made to incorporate a tongue and slit structure into the invention of Pozzobon for the purpose of allowing easier removal of feet from the liner.

It is noted that a collection of well known features, all doing what they are well-known to do, does not necessarily confer patentability.

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It is also noted that several of the references, some of which are relied upon, have the same assignee as the instant invention.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Troy Arnold whose telephone number is 703-305-0621. The examiner can normally be reached on Tuesday-Thursday, 9:30-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-0302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Troy Arnold
Examiner
Art Unit 3728

TGA
11/25/03


Mickey Yu
Supervisory Patent Examiner
Group 3700